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| 09/677,401 | 09/29/2000 | K. Jon Kern | 5125.02 | 3108 |
| 33486 | 7590 | 05/04/2006 | | EXAMINER |
| HEIMBECHER & ASSOC., LLC. 6125 SALVIA LANE ARVADA, CO 80403 | | | NGUYEN, TAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/677,401 | KERN ET AL. | |
| | Examiner | Art Unit | |
| | Tan Dean D. Nguyen | 3629 | |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-28,30 and 32-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-28, 30 and 32-91 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Remarks/Arguments

The remarks/arguments filed on 1/4/06 has been reviewed and responded as followed.

Claim Status

1. Claims 8-28, 30, 32-91 are pending. They consist of 5 method (Mt) groups, (Mt¹) 8-28, 32-46, 90, (Mt²) 47-53, (Mt³) 54-64, 91, (Mt⁴) 65-70, and (Mt⁵) 71-89.

Claims 1-7, 29, 31 have been cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8-28, 30, 32-46 (method¹), 47-53 (method²), 54, (method³), 71-89 (method⁵) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref.¹) FEIDELSON et al in view of (Ref.²) SHURLING et al.

As for Independent method claims 8 (method¹), 54 (method³), and 71 (method⁵), FEIDELSON et al fairly discloses a method of building personal financial assets by redeeming customer loyalty points comprising the steps of:

- (a) a 1st party (administrator) establishing a site on a global computer network {see Fig. 3, (300), Fig. 4};
- (b) recognizing at least certain users (2nd party) by requiring said certain 2nd party users to provide initial registration information to become recognized 2nd party users, and requiring a 1st one of the recognized 2nd party users to provide additional registration information {see Figs. 3, 4};
- (c.) directing the user to a predetermined 3rd party merchants (bank/store owner or 3rd party),
- (d) enabling accumulation of loyalty points by the user based upon transaction (service or purchase of product) from the predetermined merchant (bank/store),

(e) monitoring the transaction/purchases by the users (2nd party) from the merchant (bank/store owner),

(f) tracking the accumulated loyalty points {see Fig. 1 (3), col. 7, line 24 (or **c7:24** for abbreviation), c9:23-27, 45-50}, and

(g) permitting the user to redeem the loyalty points as monies “**rebate monies**” for building personal financial assets/gains (financial investment funds) {c9:67, c2:10}.

FEIDELSON et al fairly teaches the claimed invention except for a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation.

In another method for improving customer relationship by encouraging more sale transactions with the customer, SHURLING et al discloses a program “Loyalty Banking Program” {see col. 1, lines 15-25, and 55-67} which provide opportunity of rewarding loyalty customers who have accumulated loyalty points/incentive rewards by exchanging the points/rewards with real money/financial values such as by (1) reducing loan rate, (2) reducing bank service fee cost, or (3) increasing deposit account (CD) interest to the customer account, etc. (see col. 1, lines 30-65 (or 1:30-65), 2:10-15, 5: 1-5, 5:15-25, 9:15-20). Note that it’s well known to a skilled artisan, a money manager or bank officer, that a personal loan normally include 3 variable: amount, rate and numbers (frequency) of payments (time). Therefore, the use of any of these 3 variables for affecting a loan obligation is well known and would have been obvious to a skilled artisan. For example, instead of reducing the rate, i.e. from 10.00% to 8.00%, the bank could reduce the number of payments from 60 payments (5 years for monthly

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payments) to 48 payments and achieve the same result. Alternatively, the bank could reduce the balance one time and keep these other 2 variables the same to achieve the same results. Therefore, it would have been obvious for the banker to reduce the loan amount (or repaying the loan obligation) or number of payments as being equivalent item to reducing the loan rate to achieve similar result of reducing loan obligation, absent evidence of unexpected results.

It would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by SHURLING et al above, absent evidence of unexpected results.

As for dep. claim 9 (part of 8), the concept of tracking automatically is well known to improve efficiency and is taught on FEIDELSON et al c7:24, c9:23-27, 45-50, or SHURLING et al c8:59 or Fig. 4, (110).

As for dep. claims 10-11 (part of 8), these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and they are well known Internet communication steps and are taught in c9:40-67 of FEIDELSON et al.

As for dep. claims 12-14 (part of 8), which deals with the type of merchant and general Internet security parameters, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of various merchants and products and services as indicated by FEIDELSON

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et al Fig. 1, 8, 9, a0a, 10b, Fig. 4., or SHURLING et al on col. 2, lines 5-15, col. 4, lines 20-50.

As for dep. claims 15-18 (part of 8), which deals with the general monitoring parameters by 3rd party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of FEIDELSON et al Fig. 1, col. 5, lines 5-65, or SHURLING et al col. 4, lines 20-50.

As for dep. claims 19-21, 27-28 (part of 8), which deals with the involvement of another broker merchant or 4th party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious as mere duplicate of duplicate of parts/services for multiple effects, see St. Regis Paper Co. vs. Bemis Co., 193 USPQ 8, 11; 549 F2d 833 (7th circ. 1977).

As for dep. claims 22-26 (part of 8), which deals the relationship between various parties, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the general teachings of FEIDELSON et al and SHURLING et al.

As for dep. claims 36-37 (part of 8), which deal with the type of connection to the merchant entrance, i.e. virtual shopping mall, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by

redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 1 or col. 5, lines 5-67.

As for dep. claims 38-43 (part of 8), which deal with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 3 or col. 5, lines 5-67 and SHURLING et al on col. 2, lines 10-30.

As for dep. claims 44-46 (part of 8), which deals again with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al col. 5, lines 5-67, SHURLING et al on col. 2, lines 10-30.

As for Independent method² claim 47, which has similar limitation as in method¹ claim 8 and further limitation of additional registration information, this is fairly taught in FEIDELSON et al col. 2, lines 45-67, col. 3, lines 45-55, SHURLING et al col. 4, lines 25-35. The additional of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claim 48 (part of 47), which has similar limitation as in dep. claim 32, it's rejected for the same reason set forth in dep. claim 32 above.

As for dep. claim 49 (part of 47), these known variables are inherently included in the loan of SHURLING et al as shown on col. 5 and Tables A and B.

As for dep. claim 50 (part of 47), this is shown on cols. 10 and 11.

As for dep. claims 51, 53 (part of 47), the selection of the ratio of loyalty point to loan varies from bank to bank depends on the profit/cost structure and would have been obvious to a skilled artisan.

As for dep. claim 52 (part of 47), the selection of a 2nd loan service for the same purpose as in the 1st loan service would have been obvious as mere duplicate selection.

As for dep. claims 72-83 (part of 71), the provision of a screen providing a plurality of hyperlinks representing site contents are fairly discussed and shown on FEIDELSON et al col. 8, lines 60-67, col. 9, lines 15-50. Moreover, the selection of various hyperlinkages scenarios are considered as routine experimentations varying for each specific application and would have been obvious.

As for dep. claim 84 (part of 71), this is rejected over FEIDELSON et al as shown in Fig. 4, Fig. 5.

As for dep. claims 85-87, 89 (part of 71), they are rejected for the same reasons set forth in claims 10-11 above.

As for dep. claim 88 (part of 71), it's rejected for the same reason set forth in dep. claim 11 above.

6. Dependent claim 30, 32-35, 90 (part of 8) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al / (Ref²) SHURLING et al as applied to claims 8-28 above, and further in view of (Ref³) ARTICLE 4/1993 (All Nippon ... Frequent Flyers).

As for dep. claims 30, 90 (part of 8), in a similar method for redeeming loyalty points (bonus mileage credits), ARTICLE 4/1993 fairly discloses various options for redeeming points comprising a transfer from one user to another (2nd user) bonus mileage credits (or free ticket) to inherently allow the 2nd user to make effective use of the redeeming points as desired by the 1st user (see abstract). It would have been obvious to modify the process of FEIDELSON et al / SHURLING et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 as ways to consume the bonus or loyalty points as desired by the 1st user.

As for dep. claim 32 (part of 8), which deals with additional registration, this is fairly taught in FEIDELSON et al col. 2, lines 60-67, SHURLING et al col. 4, lines 25-35. The addition of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claims 33-35 (part of 8), the limitations of the relationship between customer's loyalty points and merchant's sale price or commission vary with each circumstance and/or merchant's profit/cost structure and are considered as optimizing operating conditions or result effective parameters/variables and the optimizing of result effective variables is considered as **routine experimentation for different scenarios or programs** to determine optimum or economically feasible loyalty point redeeming or

exchanging conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

7. Dependent claims 55-62 (part of 54) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al in view of (Ref²) SHURLING et al as applied to claims 54 above, and further in view of (Ref⁴) WONG et al (US Patent 6,119,933).

As for dep. claim 55 (part of 54), the teachings of SHURLING et al. is cited above. In a similar method for redeeming loyalty points, WONG et al displaying information about the accumulated loyalty points to the user by categorizing the points with several status such as "new", "pending", "earned", etc, and displaying the points for each status (see col. 5, lines 45-60). It would have been obvious to modify the redeeming of loyalty points of FEIDELSON et al /SHURLING et al by categorizing the points according the status and displaying the points for each status as taught by WONG et al to inherently allow accurate monitoring and using of loyalty points program.

As for dep. claims 56-62 (part of 54), the various well known limitations with respect to loyalty points monitoring program such as waiting period, displaying of points, redeeming strategy, minimum point scale, etc., are fairly discussed in WONG et al as shown on pages 5-6.

Note: WONG et al also discloses the various steps of updating profiles and adding member and member transactions as shown on cols. 4-5.

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8. **Claims 63-64, 91 (part of 8), 65-70 (method⁴) are rejected under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al in view of (Ref²) SHURLING et al (Ref⁴) WONG et al as applied to claims 55-62 above, and further in view of (Ref³) ARTICLE 4/1993.**

As for claims 63, 91 (part of 8), 65 (method⁴), the teachings of FEIDELSON et al / SHURLING et al / WONG et al is cited above. The teaching of ARTICLE 4/1993 is cited above. It would have been obvious to modify the process of FEIDELSON et al / SHURLING et al in / WONG et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 so the 2nd user can user the loyalty points if desired by the 1st user.

As for dep. claim 64 (part of 54), the number of transfer point is considered routine experimentation varying with each business model and would have been obvious.

As for dep. claim 66 (part of 65), this is taught on WONG et al on cols. 4, 5, 6.

As for dep. claims 67-70 (part of 65), these are taught on WONG et al col. 5, lines 45-60.

9. **Claims 8-28, 30, 32-46 (method¹), 47-53 (method²), 54, (method³), 71-89 (method⁵) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (Ref.¹) FEIDELSON et al in view of “GM Card” Article (Nov. 1993) and “LUX in FLUX” Article (May 1990).**

As for Independent method claims 8 (method¹), 54 (method³), and 71 (method⁵), FEIDELSON et al fairly discloses a method of building personal financial assets by redeeming customer loyalty points comprising the steps of:

- (a) a 1st party (administrator) establishing a site on a global computer network {see Fig. 3, (300), Fig. 4};
- (b) recognizing at least certain users (2nd party) by requiring said certain 2nd party users to provide initial registration information to become recognized 2nd party users, and requiring a 1st one of the recognized 2nd party users to provide additional registration information {see Figs. 3, 4};
- (c) directing the user to a predetermined 3rd party merchants (bank/store owner or 3rd party),
- (d) enabling accumulation of loyalty points by the user based upon transaction (service or purchase of product) from the predetermined merchant (bank/store),
- (e) monitoring the transaction/purchases by the users (2nd party) from the merchant (bank/store owner),
- (f) tracking the accumulated loyalty points {see Fig. 1 (3), col. 7, line 24 (or c7:24 for abbreviation), c9:23-27, 45-50}, and

(g) permitting the user to redeem the loyalty points as monies "**rebate monies**" for building personal financial assets/gains (financial investment funds) {c9:67, c2:10}. FEIDELSON et al fairly teaches the claimed invention except for a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation.

In another method for improving customer relationship by encouraging more sale transactions with the customer, GM Card Article discloses the use of loyalty points (5% of charge volume on the card) being redeemable for rebates of the purchase price of a car or van or as cash at shops {see page 1, 4th and 6th paragraphs}. "LUX in FLUX" Article is merely cited to teach (1) well known fact of obtaining of a new car is done by leasing or by obtaining a loan through the car company's credit corporation (i.e. General Motors Corp.) and (2) wherein customer can redeem loyalty points (frequent-flier miles) toward the purchase of a car {see page 2, 6th paragraph}. In other word, if the user has an amount of credit or loyalty points (1,000\$ equivalent) and the purchase price (or loan amount) of the car initially is (\$15,000), then this would reduce the purchase price or loan amount to \$14,000.00. It would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by "GM Card" Article and "LUX in FLUX" Article.

As for dep. claim 9 (part of 8), the concept of tracking automatically is well known to improve efficiency and is taught on FEIDELSON et al c7:24, c9:23-27, 45-50.

As for dep. claims 10-11 (part of 8), these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and they are well known Internet communication steps and are taught in c9:40-67 of FEIDELSON et al or "GM Card Article" and "LUX in FLUX" Article above.

As for dep. claims 12-14 (part of 8), which deals with the type of merchant and general Internet security parameters, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of various merchants and products and services as indicated by FEIDELSON et al Fig. 1, 8, 9, a0a, 10b, Fig. 4.

As for dep. claims 15-18 (part of 8), which deals with the general monitoring parameters by 3rd party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the teachings of FEIDELSON et al Fig. 1, col. 5, lines 5-65.

As for dep. claims 19-21, 27-28 (part of 8), which deals with the involvement of another broker merchant or 4th party, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious as mere duplicate of duplicate of parts/services for multiple effects, see St. Regis Paper Co. vs. Bemis Co., 193 USPQ 8, 11; 549 F2d 833 (7th circ. 1977).

As for dep. claims 22-26 (part of 8), which deals the relationship between various parties, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and would have been obvious in view of the general teachings of FEIDELSON et al and "GM Card" Article and "LUX in FLUX" Article.

As for dep. claims 36-37 (part of 8), which deal with the type of connection to the merchant entrance, i.e. virtual shopping mall, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 1 or col. 5, lines 5-67.

As for dep. claims 38-43 (part of 8), which deal with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al Fig. 3 or col. 5, lines 5-67.

As for dep. claims 44-46 (part of 8), which deals again with the types of 3rd party merchant, these are non-essential to the scope of the claimed invention which is facilitating repayment of a loan obligation by redeeming accumulated loyalty/reward points, and are fairly taught by FEIDELSON et al col. 5, lines 5-67, and "GM Card" Article and "LUX in FLUX" Article above.

As for Independent method² claim 47, which has similar limitation as in method¹ claim 8 and further limitation of additional registration information, this is fairly taught in FEIDELSON et al col. 2, lines 45-67, col. 3, lines 45-55. The additional of

other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claim 48 (part of 47), which has similar limitation as in dep. claim 32, it's rejected for the same reason set forth in dep. claim 32 above.

As for dep. claims 49-50 (part of 47), these known variables are inherently included in the loan "GM Card" Article and "LUX in FLUX" Article.

As for dep. claims 51, 53 (part of 47), the selection of the ratio of loyalty point to loan varies from bank to bank depends on the profit/cost structure and would have been obvious to a skilled artisan.

As for dep. claim 52 (part of 47), the selection of a 2nd loan service for the same purpose as in the 1st loan service would have been obvious as mere duplicate selection.

As for dep. claims 72-83 (part of 71), the provision of a screen providing a plurality of hyperlinks representing site contents are fairly discussed and shown on FEIDELSON et al col. 8, lines 60-67, col. 9, lines 15-50. Moreover, the selection of various hyperlinkages scenarios are considered as routine experimentations varying for each specific application and would have been obvious.

As for dep. claim 84 (part of 71), this is rejected over FEIDELSON et al as shown in Fig. 4, Fig. 5.

As for dep. claims 85-87, 89 (part of 71), they are rejected for the same reasons set forth in claims 10-11 above.

As for dep. claim 88 (part of 71), it's rejected for the same reason set forth in dep. claim 11 above.

10. Dependent claim 30, 32-35, 90 (part of 8) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over (Ref¹) FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article as applied to claims 8-28 above, and further in view of ARTICLE 4/1993 (All Nippon ... Frequent Flyers).

As for dep. claims 30, 90 (part of 8), in a similar method for redeeming loyalty points (bonus mileage credits), ARTICLE 4/1993 fairly discloses various options for redeeming points comprising a transfer from one user to another (2nd user) bonus mileage credits (or free ticket) to inherently allow the 2nd user to make effective use of the redeeming points as desired by the 1st user (see abstract). It would have been obvious to modify the process of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 as ways to consume the bonus or loyalty points as desired by the 1st user.

As for dep. claim 32 (part of 8), which deals with additional registration, this is fairly taught in FEIDELSON et al col. 2, lines 60-67. The additional of other well known customer information parameter for further security checking efficiency would have been obvious.

As for dep. claims 33-35 (part of 8), the limitations of the relationship between customer's loyalty points and merchant's sale price or commission vary with each circumstance and/or merchant's profit/cost structure and are considered as optimizing operating conditions or result effective parameters/variables and the optimizing of result effective variables is considered as **routine experimentation for different scenarios** or

programs to determine optimum or economically feasible loyalty point redeeming or exchanging conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

11. Dependent claims 55-62 (part of 54) are rejected under 35 U.S.C. 103(a) as being unpatentable over FEIDELSON et al in view of "GM Card" Article and "LUX in FLUX" Article as applied to claims 54 above, and further in view of (Ref⁴) WONG et al (US Patent 6,119,933).

As for dep. claim 55 (part of 54), the teachings of SHURLING et al / "GM Card" Article and "LUX in FLUX" Article is cited above. In a similar method for redeeming loyalty points, WONG et al displaying information about the accumulated loyalty points to the user by categorizing the points with several status such as "new", "pending,", "earned", etc, and displaying the points for each status (see col. 5, lines 45-60). It would have been obvious to modify the redeeming of loyalty points of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article by categorizing the points according the status and displaying the points for each status as taught by WONG et al to inherently allow accurate monitoring and using of loyalty points program.

As for dep. claims 56-62 (part of 54), the various well known limitations with respect to loyalty points monitoring program such as waiting period, displaying of points, redeeming strategy, minimum point scale, etc., are fairly discussed in WONG et al as shown on pages 5-6.

Note: WONG et al also discloses the various steps of updating profiles and adding member and member transactions as shown on cols. 4-5.

12. Claims 63-64, 91 (part of 8), 65-70 (method⁴) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over FEIDELSON et al in view of "GM Card" Article, "LUX in FLUX" Article, WONG et al as applied to claims 55-62 above, and further in view of (Ref³) ARTICLE 4/1993.

As for claims 63, 91 (part of 8), 65 (method⁴), the teachings of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article / WONG et al is cited above. The teaching of ARTICLE 4/1993 is cited above. It would have been obvious to modify the process of FEIDELSON et al / "GM Card" Article and "LUX in FLUX" Article / WONG et al by transferring the selectively redeemed loyalty points from the 1st user to a 2nd user as taught by ARTICLE 4/1993 so the 2nd user can use the loyalty points if desired by the 1st user.

As for dep. claim 64 (part of 54), the number of transfer point is considered routine experimentation varying with each business model and would have been obvious.

As for dep. claim 66 (part of 65), this is taught on WONG et al on cols. 4, 5, 6.

As for dep. claims 67-70 (part of 65), these are taught on WONG et al col. 5, lines 45-60.

Response to Arguments

13. Applicant's arguments filed 1/4/06 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's main argument is that FEIDELSON et al /SHURLING et al fail to teach the specific type of building personal gain/asset, i.e., repaying loan obligation, based upon discretionary redemption of the accumulated loyalty point in the last step (G). Applicant's argument that FEIDELSON et al fails to teach this specific limitation is noted, however, this is argument against the reference individually, since this notation has been admitted by the examiner on page 4, paragraph under (g).

Applicant's argument that SHURLING et al fails to teach this specific limitation or repaying loan obligation is noted, however, this is argument against the reference individually, since this notation has been mentioned by the examiner on page 4, last paragraph, and the reason for reducing the loan amount would have been obvious to a skilled artisan as mentioned on page 5, 1st paragraph. Note that it's well known to a skilled artisan, a money manager or bank officer, that a personal loan normally include 3 variable: amount, rate and numbers (frequency) of payments (time). Therefore, the use of any of these 3 variables for affecting a loan obligation is well known and would have

been obvious to a skilled artisan. For example, instead of reducing the rate, i.e. from 10.00% to 8.00%, the bank could reduce the number of payments from 60 payments (5 years for monthly payments) to 48 payments and achieve the same result.

Alternatively, the bank could reduce the balance one time and keep these other 2 variables the same to achieve the same results. Therefore, it would have been obvious for the banker to reduce the loan amount (or repaying the loan obligation) or number of payments as being equivalent item to reducing the loan rate to achieve similar result of reducing loan obligation, absent evidence of unexpected results. Therefore, it would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by SHURLING et al above, absent evidence of unexpected results.

Applicant's comments on pages 21-22 have been reviewed but are not persuasive since these are merely applicant's objective comments and not subjective arguments. Furthermore, no evidence have been submitted to show why it's not obvious to apply examiner's assertion on page 5, first paragraph besides applicant's opinion.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation statement is cited above, "It would have been obvious to a skilled artisan to modify the last step of FEIDELSON et al by using a different type of building personal gain/asset, i.e. reducing personal financial liability by repaying (or paying down or reducing) loan obligation as taught by SHURLING et al above, absent evidence of unexpected results".

Applicant's comments with respect to the rejections of the dependent claims are noted and that they depend on the rejections of the independent claims or mostly FEIDELSON et al /SHURLING et al with respect to the main argument of "repaying the loan obligation" are noted. However, these issues with the independent claims have been addressed above.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

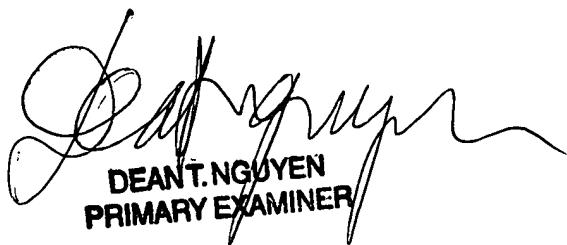
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 1, 2006



DEAN T. NGUYEN
PRIMARY EXAMINER